



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER 08/833,620	FIUNG DATE 04/07/97	FIRST NAMED APPLICANT DOBBINS	ATTY. DOCKET NO. <i>YI</i> M 15275/8610 (E)
		EXAMINER	

MICHAEL L GOLDMAN
NIXON PEABODY LLP
CLINTON SQUARE, P.O. BOX 31051
ROCHESTER NY 14603

IM62/0718

HARTMANN, LT PAPER NUMBER

30

1731
DATE MAILED:

07/18/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 7-30-00
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 1, 4-7, 10-13, 16-17, 20-23, 26-27, 30 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) 12-13, 16, 22 is/are allowed.
- Claim(s) 1, 4-7, 11, 17, 21, 23, 26-27, 30 is/are rejected.
- Claim(s) 10, 16, 20, 27 is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948

**Formal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit: 1304

DETAILED ACTION

Claim Objections

Claims 10, 16 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

These claims depend from claims 9, 15 and 19 respectively - all of which have been previously cancelled by Applicant. Thus they limit nothing. Claims 10, 16 and 20 are withdrawn from further consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6, 23, 26-27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's supplied translation of Kawaguchi JP 138145 (hereinafter referred to as '145) in view of Schwarz EP 38900.

See the previous Office action for the manner in which the art is combined and applied.

Art Unit: 1304

Claims 7, 11, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Carpenter, '145 and Schwarz.

See the previous Office action for the manner in which the art is combined. Carpenter clearly shows the limitations of claims 11 and 21

Allowable Subject Matter

Claims 12-13, and 22 are allowed.

Response to Arguments

Applicant's arguments filed 10 July 2000 have been fully considered but they are not persuasive.

Applicant argues that the showing of unexpected results rebuts the Offices determination of obviousness. Applicant has shown that for one set of parameters that the cyclosiloxane gives a deposition rate higher than a closest prior art reference siloxane. Applicant has then shown that trying to match the higher rate by (only) increasing the feed rate of the prior art siloxane yields an unusable product. It is deemed that these showings by Applicant fail to demonstrate nonobviousness. (See below)

Art Unit: 1304

First it is noted that evidence of nonobviousness does not mandate a conclusion of patentability by itself. The entire record as a whole must be weighed - including the evidence supporting the *prima facie* showing of obviousness. MPEP 716.01(d).

Second, the only basis that Powers mentions (para 7, Declaration of 03 July 2000) for the results being unexpected was that: "In view of Schwarz's disclosure hexamethyldisiloxane as preferred, the results obtained in the above experiments are highly unexpected." The only disclosure of Schwarz (that Powers refers to) is Schwarz's preference for HMDS. Powers fails to point out how a evidence of a "preference" is evidence of superior results. Powers preference could be based on cost, safety, availability, easy of use, nastiness of smell, breadth of temperature range of working, etc. Powers leap from "preference" to "superiority" is completely unfounded.

Not only has Applicant failed to show that the results are unexpected, but it appears to Examiner that the results are not unexpected. The results (para 6) of the declaration shows that the amount of silicon fed to the burner is directly proportional to the amount of silica produced - regardless of the type of siloxane: about 0.9 gm SiO₂/gm Si. In other words, the cyclosiloxanes produces more silica because they have more silicon to begin with. This is not unexpected. The additional test which increases the amount of linear siloxane but creates an inferior product is also not expected. As far as Examiner can tell, the amount of organometallic was increased, but the amount of oxygen and other gases are not increased. The size of the burner is not increased. Since the amount of raw material is increased by (37%) one would expect carbon to form because there needs to be a (37%) increase in available oxygen as well. Given the lack of oxygen, one

Art Unit: 1304

would expect to find carbon in the glass from the un-combusted hydrocarbons. (It is noted that this is not an invitation to Applicant to simply increase the amount of oxygen fed to the burner, because it is unclear if such would be "available" to the reactant - the gases would be fed at a (37%) faster velocity which would probably destroy the flame characteristics.)

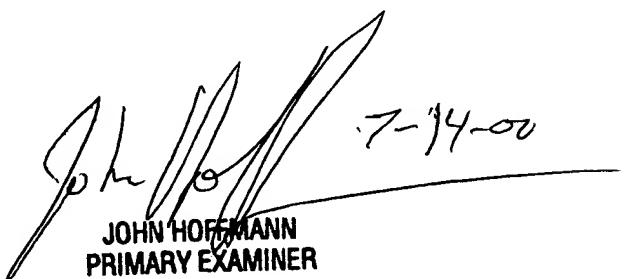
Requests for interviews

The Office initiates interviews whenever it is deemed that it would be beneficial to do so to advance prosecution. And when an Applicant wishes to have an interview, the burden to initiate the interview remains solely with Applicant. MPEP 408 notes that Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interview would not be effective; therefore, requests for the Office to initiate interviews will not be acknowledged.

MPEP 713.05, 713.03, 713.09, and 713.01 and common sense indicate that any of the following questions would be appropriate for the Office to ask prior to granting an interview: Has there already been an interview of record in the case? Will the interview last more than 30 minutes? When do you want the interview? Does Applicant's representative have Power of Attorney? Does Applicant's representative have authority to bind the principal concerned? (i.e. Does Applicant's representative have authority to make any and all changes?) Who will participate in the interview? What is the intended purpose(s) of the interview? What is the intended content of the requested interview? Failure to volunteer the above information might-possibly result in a denial of an interview, or the inability of the Examiner to adequately answer Applicant's questions during the interview.

CONTACT INFORMATION

Examiner's number	(703) 308-0469
fax- official papers after a final rejection	305-3599
fax- official papers (all others)	305-7718
fax- unofficial papers	305-7115
Group Receptionist	308-0651



7-14-00
JOHN HOFFMANN
PRIMARY EXAMINER